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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/751,349	12/28/2000	Jeffrey S. Hamilton	T730-10	8813

27832 7590 06/30/2005

TECHNOLOGY, PATENTS AND LICENSING, INC./PRIME
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EXAMINER	
MANNING, JOHN	

ART UNIT	PAPER NUMBER
2614	

DATE MAILED: 06/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/751,349	HAMILTON ET AL.	
	Examiner	Art Unit	
	John Manning	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *19-42* is/are pending in the application.

4a) Of the above claim(s) *1-18* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *19-42* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 19-42 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 19-28, 31-34 and 35-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuria in view of Sullivan et al. (US Pat No 6,593,973).

In regard to claim 19, the Tsuria reference discloses a device for displaying an alternate signal on a screen of a video display device during a tune operation. The claimed limitation of "a memory for storing one or more local signals" is met by the memory unit 30 of Figure 1. "The advertisement data is processed by processor 28 and stored in memory unit 30" (Col 3, Lines 60-61). The claimed limitation of "a processor for recognizing the delay period associated with the channel change command, wherein the inherent delay period is the time to acquire and decode a digital television signal" is met by processor 28 of Figure 1. The claimed limitation of "a signal insertion module, coupled to the memory and the processor, for retrieving a local signal from the memory"

is also met by processor 28 of Figure 1. "During zapping periods, processor 28 is operable to retrieve the advertisement data from memory 30 and to provide it, via D/A 26, to combiner and amplifier 32 for displaying the advertisement data on television 14" (Col 3, Lines 61-65). Tsuria is silent with respect to the limitation of "creating a second delay period for inserting the local signal in the second delay period, wherein the second delay period is longer than the inherent delay period". The Sullivan et al. reference teaches creating a second delay period for inserting the local signal in the second delay period, wherein the second delay period is longer than the inherent delay period so to ensure a complete presentation of a video transition. "While it is understood that a preferred embodiment of the present invention places a video transition into a system's normally generated transition period, for purposes of defining a method of doing business, the system of the present invention may be designed to generate and provide a predetermined transition period when switching from one video source or channel to another video source or channel, in order to ensure a complete presentation of a video transition." (Col 6, Lines 6-13). Consequently, it would have been obvious to one of ordinary skill in the art to implement Tsuria with creating a second delay period for inserting the local signal in the second delay period, wherein the second delay period is longer than the inherent delay period so to ensure a complete presentation of a video transition.

In regard to claim 20, Tsuria discloses the use of targeted advertisements. The displayed advertisements are associated with the channel the use is tuned to. The "separate advertisements are associated with separate channels. An advertisement is

displayed on television 14 only between the times a subscriber changes his selection from a previously selected channel which he is currently viewing and the time the next selected channel is displayed on television 14" (Col 3, Lines 66-67; Col 4, Lines 1-4).

In regard to claim 21, Tsuria discloses that the "local signal" is an audio signal. The "CATV source 15 is operable to transmit advertisement data, preferably in the form of slides accompanied by voice data" (Col 3, Lines 55-57), where the voice data is clearly an audio signal.

In regard to claim 22, Tsuria discloses that the "local signal" is a graphics signal. The "CATV source 15 is operable to transmit advertisement data, preferably in the form of slides accompanied by voice data" (Col 3, Lines 55-57), where the slides are clearly a graphics signal.

In regard to claim 23, Tsuria discloses a device for displaying an alternate signal on a screen of a video display device during a tune operation for use in a digital CATV system. Therefore, it is inherent that system has a demultiplexer for recalculating a new program stream based on the channel change command.

In regard to claim 24, Grossman discloses that market considerations can determine the duration of the time interval. Additional advertisements are interpreted to be a market consideration. "In the preferred embodiment of the invention it is believed that a suitable duration for the interdisplay time interval can be between approximately thirty seconds and approximately fifty seconds, with an interval of approximately forty seconds being the most preferred. In practice, however, it is believed that market

considerations will determine the duration of the interdisplay time interval" (Col 5, Lines 22-28).

In regard to claim 25, the claimed method is met by Figure 1. The claimed step of "recognizing the inherent delay period associated with the execution of the channel change command, wherein the inherent delay period is the time to acquire and decode a digital television signal" is carried out by processor 28 of Figure 1. The claimed steps of "transmitting a request for a local signal, wherein the local signals are stored in memory" and "receiving a local signal in response to the transmitted request" are met by processor 28 and memory unit 30 of Figure 1. The claimed step of "inserting the local signal during the delay period" is met by Figure 1. "During zapping periods, processor 28 is operable to retrieve the advertisement data from memory 30 and to provide it, via D/A 26, to combiner and amplifier 32 for displaying the advertisement data on television 14" (Col 3, Lines 61-65). Tsuria is silent with respect to the limitation of "creating a second delay period for inserting the local signal in the second delay period, wherein the second delay period is longer than the inherent delay period". The Sullivan et al. reference teaches creating a second delay period for inserting the local signal in the second delay period, wherein the second delay period is longer than the inherent delay period so to ensure a complete presentation of a video transition. "While it is understood that a preferred embodiment of the present invention places a video transition into a system's normally generated transition period, for purposes of defining a method of doing business, the system of the present invention may be designed to generate and provide a predetermined transition period when switching from one video

source or channel to another video source or channel, in order to ensure a complete presentation of a video transition." (Col 6, Lines 6-13). Consequently, it would have been obvious to one of ordinary skill in the art to implement Tsuria with creating a second delay period for inserting the local signal in the second delay period, wherein the second delay period is longer than the inherent delay period so to ensure a complete presentation of a video transition.

In regard to claim 26, Tsuria discloses the use of targeted advertisements. The displayed advertisements are associated with the channel the use is tuned to. The "separate advertisements are associated with separate channels. An advertisement is displayed on television 14 only between the times a subscriber changes his selection from a previously selected channel which he is currently viewing and the time the next selected channel is displayed on television 14" (Col 3, Lines 66-67; Col 4, Lines 1-4).

In regard to claim 27, Tsuria discloses that the "local signal" is an audio signal. The "CATV source 15 is operable to transmit advertisement data, preferably in the form of slides accompanied by voice data" (Col 3, Lines 55-57), where the voice data is clearly an audio signal.

In regard to claim 28, Tsuria discloses that the "local signal" is a graphics signal. The "CATV source 15 is operable to transmit advertisement data, preferably in the form of slides accompanied by voice data" (Col 3, Lines 55-57), where the slides are clearly a graphics signal.

In regard to claim 31, Tsuria indicated that the disclosed system may also be used in an analog CATV system. And, the "CATV source 15 is operable to transmit advertisement data" (Col 3, Lines 55-56), which would be an analog TV channel.

In regard to claim 32, Sullivan discloses locally stored MPEG stream.

In regard to claim 33, Tsuria discloses a device for displaying an alternate signal on a screen of a video display device during a tune operation for use in a digital CATV system. Therefore, it is inherent that system has a demultiplexer for recalculating a new program stream based on the channel change command.

In regard to claim 34, Sullivan discloses creating a delay long than the inherent delay to display advertisements that would not normally be presented.

In regard to claim 35, the claimed method is met by Figure 1. The claimed step of "recognizing the inherent delay period associated with the execution of the channel change command to switch from a first channel to a second channel, wherein the inherent delay period is the time to acquire and decode a digital television signal" is carried out by processor 28 of Figure 1. The claimed steps of "transmitting a request for a local signal, wherein the local signals are stored in memory" and "receiving a local signal in response to the transmitted request" are met by processor 28 and memory unit 30 of Figure 1. The claimed step of "inserting the local signal during the delay period" is met by Figure 1. "During zapping periods, processor 28 is operable to retrieve the advertisement data from memory 30 and to provide it, via D/A 26, to combiner and amplifier 32 for displaying the advertisement data on television 14" (Col 3, Lines 61-65). Tsuria is silent with respect to the limitation of "manipulating the inherent delay period

such that a program associated with the second channel is delayed until the local signal is terminated". The Sullivan et al. reference teaches manipulating the inherent delay period such that a program associated with the second channel is delayed until the local signal is terminated so to ensure a complete presentation of a video transition. "While it is understood that a preferred embodiment of the present invention places a video transition into a system's normally generated transition period, for purposes of defining a method of doing business, the system of the present invention may be designed to generate and provide a predetermined transition period when switching from one video source or channel to another video source or channel, in order to ensure a complete presentation of a video transition." (Col 6, Lines 6-13). Consequently, it would have been obvious to one of ordinary skill in the art to implement Tsuria with manipulating the inherent delay period such that a program associated with the second channel is delayed until the local signal is terminated for the stated advantage.

In regard to claim 36, Tsuria discloses the use of targeted advertisements. The displayed advertisements are associated with the channel the use is tuned to. The "separate advertisements are associated with separate channels. An advertisement is displayed on television 14 only between the times a subscriber changes his selection from a previously selected channel which he is currently viewing and the time the next selected channel is displayed on television 14" (Col 3, Lines 66-67; Col 4, Lines 1-4).

In regard to claim 37, Tsuria discloses that the "local signal" is an audio signal. The "CATV source 15 is operable to transmit advertisement data, preferably in the form

of slides accompanied by voice data" (Col 3, Lines 55-57), where the voice data is clearly an audio signal.

In regard to claim 38, Tsuria discloses that the "local signal" is a graphics signal. The "CATV source 15 is operable to transmit advertisement data, preferably in the form of slides accompanied by voice data" (Col 3, Lines 55-57), where the slides are clearly a graphics signal.

In regard to claim 40, Tsuria indicated that the disclosed system may also be used in an analog CATV system. And, the "CATV source 15 is operable to transmit advertisement data" (Col 3, Lines 55-56), which would be an analog TV channel.

In regard to claim 41, Sullivan discloses locally stored MPEG stream.

In regard to claim 42, Sullivan discloses creating a delay long than the inherent delay to display advertisements that would not normally be presented.

4. Claims 29-30 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuria in view of Sullivan et al. and in further view of Zigmond et al.

In regard to claim 29, the combination of Tsuria and Sullivan disclose a device for displaying an alternate signal on a screen of a video display device during a tune operation. The combined teaching fails to explicitly disclose that the "local signal" is an HTML page. Zigmond et al. teaches the use of HTML as a local signal so as to provide "advertisements originating from advertisers that traditionally have not had access to television or advertising production resources for economic or other reasons" (Col 9, Lines 15-18). The "advertisements delivered from ad source 62 are inexpensively converted from traditionally non-video media. For example, text, graphics, pictures, or

audio from a computer generated document (i.e., an HTML page) is converted into a video display such as a freeze-frame or slide show" (Col 9, Lines 8-14). Consequently, it would have been clearly obvious to one of ordinary skill in the art to implement the combined teaching with the use of HTML as a local signal so as to provide "advertisements originating from advertisers that traditionally have not had access to television or advertising production resources for economic or other reasons" (Col 9, Lines 15-18).

In regard to claim 30, the combined teaching of claim 10 discloses a device for displaying an alternate signal on a screen of a video display device during a tune operation. The combined teaching fails to explicitly disclose that the "local signal" is a Java application. However, the examiner takes OFFICIAL NOTICE that it is notoriously well known in the art to use a Java application as a "local signal" so a to provide an interactive advertisement. Consequently, it would have been clearly obvious to one of ordinary skill in the art to implement the combined teaching with Java application as a "local signal" so a to provide an interactive advertisement.

In regard to claim 39, the combination of Tsuria and Sullivan disclose a device for displaying an alternate signal on a screen of a video display device during a tune operation. The combined teaching fails to explicitly disclose that the "local signal" is an HTML page. Zigmond et al. teaches the use of HTML as a local signal so as to provide "advertisements originating from advertisers that traditionally have not had access to television or advertising production resources for economic or other reasons" (Col 9, Lines 15-18). The "advertisements delivered from ad source 62 are inexpensively

converted from traditionally non-video media. For example, text, graphics, pictures, or audio from a computer generated document (i.e., an HTML page) is converted into a video display such as a freeze-frame or slide show" (Col 9, Lines 8-14). Consequently, it would have been clearly obvious to one of ordinary skill in the art to implement the combined teaching with the use of HTML as a local signal so as to provide "advertisements originating from advertisers that traditionally have not had access to television or advertising production resources for economic or other reasons" (Col 9, Lines 15-18).

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Manning whose telephone number is 571-272-7352. The examiner can normally be reached on M-F: 9:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JM
June 15, 2005

JOHN MILLER
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